Remarks/Arguments

Claims 1-21 are pending in this application. Claims 1, 8, and 15 have been amended to more clearly and distinctly claim the subject matter that applicants regard as their invention. No new matter is believed to be added by the present amendment.

Re: Rejection of Claims 1, 6, 8, 9, 14, 15 and 21 under 35 U.S.C. §103(a)

Claims 1, 6, 8, 9, 14, 15, and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,987,221 issued to Platt (hereinafter, "Platt") in view of U.S. Patent No. 6,044,047 issued to Kulas (hereinafter, "Kulas"), and further in view of U.S. PGPub 2003/0144918 issued to Novelli (hereinafter, "Novelli"). Applicants respectfully traverse this rejection for at least the following reasons.

For the sake of brevity, Applicants will be focusing on the arguments below with respect to amended claim 1.

First, applicants submit that the proposed combination of references fail to produce the claimed invention.

Kulas pertains to a multi-CD player with a quick scanning feature where the multi-CD player stores samples of a portion of each of the CDs that are played back quickly so that a user can select which CD to play based on the samples (see abstract). A sample is generated when the CD is first loaded into the multi-player and is stored in a memory (col. 3, lines 11-14). The multi-CD player in Kulas contains a fixed number of slots, N, that house at most N CDs.

The quick scanning feature is activated by simply pressing a button on the multi-CD player (Fig. 2, 160). The quick scanning feature plays each sample in the same order as its corresponding CD is housed in the slots - starting with the sample associated with the CD housed in slot 0 and ending with the sample associated with the CD housed in slot N (see Fig. 3).

If a sample has not been made before the quick scanning feature is activated, the sample is made during the quick scanning process (see Fig. 3). Kulas relies on samples being generated from a multi-CD player that reads the audio data from tracks on the spinning CD thereby requiring a motor, a pickup head, spindle servo, and other mechanical elements to be activated to make this sample.

Novelli allows a user to activate a button on a portable music player so that the music player can mark the currently playing track of music as a reminder that the user wishes to carry out a future action associated with the music track at a later time (see Novelli, col. 6, lines 20 -23). The music player stores the reminder, a marked track, in its memory. The music player is connected to a personal computer. The list of the marked tracks is transferred to the PC and the user interacts with the PC to carry out the future actions.

The user is provided with a menu showing all the marked tracks and the additional actions available to the user. These actions can be to purchase the marked music selection, search for information regarding the marked music selection, and other transactions that require the use of the Internet (see Novelli, col. 7, lines 60 – col. 8, line 9). The user selects from this menu the actions or information that is of interest.

Amended claim 1 recites:

A method of compiling a playlist of digital audio data files using a digital audio data player, the method comprising the steps of:

enabling a user to select a set of digital audio data files for potential inclusion in the playlist via a user input device associated with the digital audio data player;

sequentially playing an audio clip from each one of the user-selected digital audio data files via an audio output device associated with the digital audio data player;

detecting whether a user input is received via the user input device while each one of the audio clips is being played; and

including identifying data for the digital audio data file associated with a currently playing audio clip in the playlist in response to detecting the user input while the currently playing audio clip is being played.

The Examiner contends that the "sequentially playing" step above is taught in Kulas at col. 5 lines 18-50. Applicants respectfully disagree.

Amended claim 1 recites "*sequentially playing an audio clip from each one of the user-selected digital audio data files via an audio output device associated with the digital audio data player (emphasis added)."* The quick scanning feature of Kulas plays all the samples from each CD loaded into the player in the same order that the sampled CD is housed in the CD player. By contrast, amended claim 1 recites that the audio clips that are played are user-selected, that is, the user determines which audio clips are played. Clearly, this feature is not recited in Kulas.

Furthermore, the following features of amended claim 1 are not recited in Kulas.

Amended claim 1 recites "*enabling a user to select a set of digital audio data files for potential inclusion in the playlist via a user input device associated with the digital audio data player (emphasis added)."* Again, there is no playlist in Kulas and, at least, this feature is not recited in Kulas.

Amended claim 1 recites "*including identifying data for the digital audio data file associated with a currently playing audio clip in the playlist in response to detecting the user input while the currently playing audio clip is being played (emphasis added)."* Again, there is no playlist in Kulas and Kulas does not recite "*including identifying data*" as noted above. For these reasons, at least, these features are not recited in Kulas.

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The following features of amended claim 1 are not recited in Novelli.

Amended claim 1 recites "*enabling a user to select a set of digital audio data files for potential inclusion in the playlist via a user input device associated with the digital audio data player (emphasis added).*" Novelli recites a list of marked tracks. The list is used to search for and display transactions that a user can initiate with respect to each marked track. The marked track list differs from a playlist. Clearly, the playlist is not recited in Novelli.

Amended claim 1 recites "*sequentially playing an audio clip from each one of the selected digital audio data files via an audio output device associated with the digital audio data player.*" Novelli does not recite sequentially playing an audio clip as noted above. This feature, at least, in amended claim 1 is not recited in Novelli.

Amended claim 1 recites "*including identifying data for the digital audio data file associated with a currently playing audio clip in the playlist in response to detecting the user input while the currently playing audio clip is being played (emphasis added).*" Novelli does not recite a playlist nor recite "*including identifying data*" as noted above. For these reasons, this feature in amended claim 1 is not recited in Novelli.

Therefore, even assuming that the references are combined as suggested by the examiner, the combined arrangement still fails to produce the claimed invention.

Furthermore, applicants submit that the Office Action has failed to provide sufficient motivation why one skilled in the art would combine the references in the manner suggested.

The Examiner contends that "*[o]ne would have been motivated to combine Platt and Kulas for the purpose of allowing a user to quickly traverse a large library of media items and select desired files for purchase, reproduction, copy or inclusion into a playlist.* Applicants respectfully disagree.

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One skilled in the art would quickly realize that Kulas is not suited for a large library of media items. The creation of each sample involves the playback of a CD from a mechanical player which takes a significant amount of time (see col. 1, lines 39 – 42, , "*This is very inconvenient because the lower cost multi-CD players, and even the higher cost multi-CD players, require 10 -15 seconds to load, spin up, and being playing each CD.*").

One skilled in the art would recognize that in Kulas there is a large overhead in generating a sample that is created from having a motor spin the CD so that the servo could position the pickup head over the requisite data track. This mechanical overhead would be time consuming for a large library of media items such that it would deter one skilled in the art from using Kulas for a large library of media items.

One skilled in the art would also recognize that Kulas plays every sample stored in the large library of media items. This would be time consuming and deter one from using Kulas for a large library of media items.

Furthermore, there would be no motivation to modify Platt in a manner that would require additional user time and effort (see Platt, col. 2, lines 30 – 36). Kulas requires a user to listen to all the samples and to manually select the associated CD. This could be a significant amount of time for a large library of media files. Even if the user were to use the fast forward control to skip through some of the samples, it would still take a considerable amount of time to go through a large library. In addition, there is the manual effort on the user's part to go through the selection process. For these reasons, one skilled in the art would be deterred from combining Platt with Kulas, when Platt's main objective is to minimize the user's time and effort.

The Examiner also contends that "*[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to operate the Platt disclosed "ADD" button during playback of a media file as taught by Novelli, thereby indicating preference on the part of the user to include a media item in the Platt playlist and*

causing the sequential reproduction of a next item in the Kulas disclosed sequential stepping method." Applicants respectfully disagree.

One skilled in the art would not modify Platt with Novelli in a manner that would require additional user time and effort (see Platt, col. 2, lines 30 – 36). In fact, Novelli is targeted for user interactions. The user has to mark the tracks of interest, the user downloads the track list to the PC, and the user initiates each subsequent transaction from the menu of options. By contrast, Platt's objective is to minimize the user's manual interactions. One skilled in the art would not combine Platt with Novelli in a manner that relies on a significant amount of user interaction. Additionally, one skilled in the art would not further the combination of Platt and Kulas to add Novelli, which again relies on significant user effort and time.

The lack of motivation to combine Platt, Kulas, and Novelli is further supported by the fact that only one of these references, namely Platt, even addresses the problem of *how to create a playlist using a digital audio data player*, as claimed. Kulas does not recite a playlist and is directed towards solving a problem that is specific to a CD player (see, for example, col. 1, lines 46 – 48, "*It is desirable to have a quick scanning feature in multi-CD players so that a user can quickly determine and select a desired CD for playback.*"). Novelli is directed towards creating a reminder of a currently playing music track for future reference. Accordingly, one of ordinary skill in the art, when faced with the problem of *how to create a playlist using a digital audio data player*, would not be motivated to examine art, such as Kulus and Novelli, which are directed towards solving completely different problems.

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Conclusion

The remaining independent claims recite the above-referenced features, and are believed to be patentably distinguishable over the cited references for the same reasons as discussed with respect to amended claim 1.

Applicants submit that for at least the reasons discussed above the suggested combination of prior art references fail to disclose or suggest each and every feature recited in the independent claims 1, 8, and 15, and as such, these claims, and the claims that depend there from, are patentably distinguishable over the cited references.

Re: Claims 2-5, 10-13, and 17- 20 rejected under 35 U.S.C. §103(a)

Claims 2-5, 10-13, and 17-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Platt in view of Kulas in view of Novelli as applied to claims 1, 6, 8, 14, 15, 21 above and further in view of Heo (US Patent 7,046,588), (hereinafter, "Heo").

Applicants respectfully traverse this rejection since Heo is unable to remedy the deficiencies of Platt, Kulas, and Novelli explained above in conjunction with independent claims 1, 8 and 15. Accordingly, withdrawal of the rejection is respectfully requested.

Re: Claims 7, 16 rejected under 35 U.S.C. §103(a)

Claims 7, 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Platt in view of Kulas in view of Novelli as applied to claims 1, 6, 8, 14, 15, 21 above and further in view of Eyal et al. (US PGPub 2002/0116476), (hereinafter, "Eyal").

Applicants respectfully traverse this rejection since Eyal is unable to remedy the deficiencies of Platt, Kulas, and Novelli explained above in conjunction with independent claims 1, 8 and 15. Accordingly, withdrawal of the rejection is respectfully requested.

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Conclusion

In view of the foregoing remarks/arguments and accompanying amendments, the Applicants believe this application stands in condition for allowance. Accordingly, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the Applicants' attorney at (609) 734-6815, so that a mutually convenient date and time for a telephonic interview may be scheduled.

It is believed that there are no additional fees due with regard to the filing of this response. However if an additional fee is due, please charge the fee, or credit any overpayment, to Deposit Account No. 07-0832.

Respectfully submitted,

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